



Handwritten initials: J/W and #F

PATENT
Customer No. 22,852
Attorney Docket No. 05725.1009-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Gilles RUBINSTENN et al.)	Group Art Unit: 3639
)	
Application No.: 10/024,351)	Examiner: Borissov, Igor N.
)	
Filed: December 21, 2001)	
)	
For: CUSTOMIZED BEAUTY)	Confirmation No.: 4841
TRACKING KIT)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants submit this Reply Brief in response to the Examiner's Answer mailed October 4, 2005.

If there are any fees due in connection with the filing of this Reply Brief that are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

I. INTRODUCTION

In the Examiner's Answer, the rejection of claims 1-25 and 28-30 under 35 U.S.C. § 102(a) as anticipated by PCT International Publication No. WO 01/18674 A2 ("*Maloney*") was withdrawn (Examiner's Answer, p. 2), and the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of U.S. Patent No. 6,293,284 was withdrawn (Examiner's Answer, p. 3). Consequently, the sole outstanding rejection at issue in this appeal is the rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter.

Appellants submit this Reply Brief to address various assertions set forth in the Examiner's Answer.¹ Specifically, Appellants address the Examiner's improper reliance on a "technological arts" test in the § 101 rejection of claims 1-10 and 24-30.

II. ARGUMENT IN REPLY

A. The rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 should be reversed because these claims define statutory subject matter

1. The Examiner's "technological arts" test is improper

In the Examiner's Answer, the Examiner alleged that claims 1-10 and 24-30 are "not within the technological arts." Examiner's Answer at 6. The Examiner's Answer also reiterated the allegation that the claims "are completely silent with regard to technology and [are directed to] . . . purely an abstract idea or process steps that are employed without the use of any technology whatsoever." Examiner's Answer at 8.

¹ Appellants have endeavored to address assertions in the Examiner's Answer without unduly repeating the same arguments in Appellants' Brief filed July 22, 2005.

For at least the reasons set forth in Appellants' Appeal Brief filed July 22, 2005, the Examiner's "technological arts" rejection of claims 1-10 and 24-30 is improper and should be reversed. Indeed, very recently the Board of Patent Appeals and Interferences confirmed that there is no judicially-recognized, separate "technological arts" test to determine eligible subject matter under § 101. *Ex Parte Lundgren* (Bd. Pat. App. & Int., No. 2003-2088, Oct. 2005).

2. Claims 1-10 and 24-30 are not abstract and are therefore statutory

The Examiner's Answer reiterated the allegation that the claims are "abstract ideas which can be performed mentally without interaction of a physical structure." Examiner's Answer at 6. The Examiner's Answer, however, did not squarely address numerous remarks in Appellants' Brief explaining that claims 1-10 and 24-30 do in fact include recitations that produce "concrete, tangible and useful" results and thus accomplish a practical application and are not abstract. *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 at 1373, 47 USPQ2d (BNA) 1596 at 1600-01 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 at 1358 (Fed. Cir. 1999), 50 USPQ2d 1447 at 1451-1452. Instead, the Examiner merely alleged that "the claimed invention is not within the technological arts" without setting forth any meaningful basis for such an allegation. Examiner's Answer at 6.

The Examiner's analysis is improper. As explained above, there is no judicially-recognized, separate "technological arts" test to determine eligible subject matter under § 101. If a claim includes recitations that produce "a concrete, tangible and useful result," the claim is not abstract and has practical utility. *See State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-01; *AT&T Corp.*, 172 F.3d at 1358,

50 USPQ2d at 1451-52. And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

For at least the reasons set forth in Appellants' Appeal Brief filed July 22, 2005, claims 1-10 and 24-30 do indeed include recitations that produce "concrete, tangible and useful" results and are therefore not abstract but, rather, statutory under 35 U.S.C. § 101. *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-01. In particular, Applicants reiterate that the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations "reflects a misunderstanding of...[the] case law." *AT&T Corp.*, 172 F.3d at 1359 (emphasis added), 50 USPQ2d at 1452-1453. Because claims 1-10 and 24-30 are statutory, the § 101 rejection of claims 1-10 and 24-30 should be reversed.

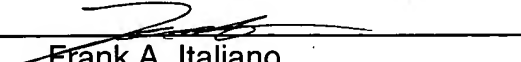
III. CONCLUSION

For the reasons set forth above, and those in Appellants' opening Brief, the outstanding rejection of claims 1-10 and 24-30 is improper and should be reversed. Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection of pending claims 1-10 and 24-30 and place this application in condition for allowance.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 5, 2005

By: 
Frank A. Italiano
Reg. No. 53,056

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
Customer No. 22,852